

REMARKS

This Application has been carefully reviewed in light of the final Office Action electronically sent February 7, 2008. Claims 1-15 are pending in the application and are rejected. Applicants submit that the pending claims are patentably distinguishable over the cited references for the reasons given below. Applicants, therefore, respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Office Action rejects Claims 1-6, 9, and 15 under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent No. 5,923,736 issued to Shachar ("*Shachar*") in view of U.S. Patent No. 6,584,096 issued to Allan ("*Allan*").

Claim 1 of the Application, as amended, recites the following limitations:

A telephone for providing content to a client external to the telephone, the telephone and the client each separately coupled to a communications network, the telephone comprising:

a network interface operable to couple the telephone to the communications network;

a handset operable to provide oral communication by a user of the telephone using the network interface;

a memory operable to store communication software and content for delivery to the client using the network interface, the content associated with the operation of the telephone; and

a processor coupled to the memory and operable to execute the communication software to enable the telephone to:

receive a request from the client via the network interface for the content stored in the memory;

transmit the content from the telephone to the client via the network interface in response to the request, the content transmitted in a format for presentation in a graphical user interface on the client;

receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface; and

execute the requested telephone-related option.

Independent Claims 9 and 15 recite similar, although not identical, limitations.

Applicants respectfully submit that the *Shachar-Allan* combination does not disclose, teach or suggest these limitations. First, the proposed combination does not disclose, teach

or suggest a telephone that can “receive a request from the client via the network interface for the content stored in the memory” and “transmit the content from the telephone to the client via the network interface in response to the request, the content transmitted in a format for presentation in a graphical user interface on the client.” For a teaching of these limitations, the Office Action relies on a combination of the disclosure of telephone 100 of *Shachar* (its shortcomings being discussed in Applicants’ previous Response) with the network device 14 of *Allan*, which that reference says can be a telephone and can be a server application device. However, *Allan* never discloses that network device 14 when implemented as a telephone can serve web pages or otherwise provide content for presentation in a graphical user interface on a client. Although *Allan* mentions web page hosting, it describes network device 14 very generically as basically any type of IP device and never links telephony functionality with web hosting functionality. For example, in a passage cited in the Office Action (Col. 5, lines 35-42), *Allan* specifically distinguishes between a telephony server application and a web page hosting server application. Simply because *Allan* states that network device 14 when implemented as a telephone can act as a server to provide an *IP telephony* server application does not mean that *Allan* discloses or makes obvious that a telephone can act as a web server.

Furthermore, Claim 1 further requires that the telephone “receive a request from the client via the network interface to execute a telephone-related option selected by the user of the client in the graphical user interface” and “execute the requested telephone-related option.” There is absolutely no teaching or suggestion of this in either of the references, alone or in combination. Instead, the Office Action argues that this remote execution of a telephone-related option would have been obvious because “[o]ne skilled in the art would have been motivated to make the combination in order to be able to use the digital answering machine 106, fax service 107, or other services 108 [of telephone 100] remotely since it already serves as a local internal server” (citing Col. 13, lines 55-62 of *Shachar*). However, telephone 100 does not act as a “local internal server.” As recognized by *Shachar* at Column 12, lines 25-31, telephone 100 is a browser. A server provides content to a remotely located client, so by definition, telephone 100 is not a server (or, in other words, “local internal” are inconsistent with “server”). The point is that *Shachar* never contemplates serving the hypertext documents to a remote location to enable remote control of telephone 100. *Allan* also does not suggest any sort of remote operation of network device 14.

Applicants respectfully submit that the obviousness analysis provided by the Office Action is based on hindsight and uses the teachings of the present invention (remote operation of a telephone enabled by the serving of content from the telephone) to assert that the present invention is obvious, which is impermissible. *See, e.g., In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). None of the cited art disclose, teaches or suggests remote operation of a telephone enabled by the serving of content from the telephone, and thus Applicants respectfully submit that Claim 1 is allowable. Therefore, Applicants respectfully request reconsideration and allowance of Claim 1, as well as the claims that depend from Claim 1.

Furthermore, independent Claims 9 and 15 include limitations that are similar to those of Claim 1, and thus these claims are allowable for similar reasons. Thus, Applicants also respectfully request reconsideration and allowance of Claims 9 and 15, as well as the claims that depend from Claim 9.

The Office Action also rejects Claims 7, 8, and 10-14 under 35 U.S.C. § 103(a) as being unpatentable over *Shachar* in view of *Allen* and further in view of U.S. Patent No. 6,430,174 issued to Jennings ("*Jennings*").

Claims 7, 8, and 10-14 each depend from one of independents Claims 1 and 9, which were shown above to be in condition for allowance. Therefore, for at least this reason, Applicants submit that Claims 7, 8, and 10-14 are also in condition for allowance. Thus, Applicants respectfully request reconsideration and allowance of Claim 7, 8, and 10-14.

CONCLUSION


Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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